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In re: O'NEILL, et al. : Decision on Petition for
Serial No. 10/615133 : Withdrawal of Finality of
Filed : July 08, 2003 : an Office Action

**For: OBSCURATION METHOD FOR
REDUCING THE INFRARED SIGNATURE
OF AN OBJECT**

This is a decision on the petition under 37 CFR 1.181, received on August 31, 2006 for withdrawal of the finality of an Office action.

The applicant's petition is GRANTED-IN-PART.

A final rejection was mailed on January 31, 2006. In that action, the statement of rejection in paragraph 9 omitted claims 13 and 21. The text of the rejection identified how each of the claims applied to the rejection. This text is found in paragraphs 10-28. Within that text, at paragraphs 17 and 24, claims 13 and 21 are specifically mentioned and their the applicability to the art recited. A similar mistake was made in the non-final office action mailed on June 28, 2005. It is noted that paragraph 30 of the final rejection clarifies this mistake.

In an advisory action mailed on August 14, 2006, the examiner notices the mistake in the final action and attached a corrected copy of the Final action with claims 13 and 21 in the statement of the rejection.

Petitioner raises two points of concern in the petition:

- 1.) attaching a corrected final action to the advisory action is improper and the addition of claims 13 and 21 amounts to a new ground of rejection; and
 - 2.) claims 13 and 21 were rejected for the first time in the attachment to the advisory action and therefore the Office should nullify this advisory and issue the attachment as a non-final office action.

A review of the history points to an oversight of the examiner of not mentioning claims 13 and 21 in the statement of the rejection. The examiner in paragraph 30 of the final office action points this out. Apparently, through a "cut and paste" operation, the examiner made the same omission in the final action. However, it is reasonable to apply the same statement made in paragraph 30 to the omission in the final action.

Therefore, upon reviewing the history, it is reasonable to assume that claims 13 and 21 are in fact rejected since they are clearly addressed in the body of the action and the examiner addressed the exact same omission that occurred in the non-final action. Although the attachment is viewed as merely a correction of an omission for the benefit of the applicant, it is improper to send out as an attachment to an advisory action. In this case the attachment should have been sent out as a corrected office action.

The petition with respect to the first point raised by the applicant is GRANTED.

With respect to the second point, the attachment to the advisory is not considered a "new" final office action and does not raise any new ground of rejection since the rejection of the claims were clearly pointed out in the body of the rejection.

The petition with respect to the second point raised by the applicant is DENIED.

The Final rejection mailed on January 31, 2006 has been withdrawn in a replacement Office action dated October 13, 2006. Therefore, no further action is required by the examiner with respect to this petition.

Any questions or comments with respect to this decision should be forwarded to Michael J. Carone at (571) 272-6873.



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